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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/669,656    06/24/96    WOOD    J    70086

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HM12/0717

EXAMINER

ALLEN, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

07/17/01

23

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

7/17/01

**Office Action Summary**

Application No.

08/669,656

Applicant(s)

WOOD ET AL.

Examiner

Marianne Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-10, 13, 14, 17-33, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 10, 13, 14 and 18-29 is/are allowed.
- 6) ☒ Claim(s) 8, 17, 30-33, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.5                      6) ☐ Other:

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### **DETAILED ACTION**

Claims 8-10, 13-14, 17-33, and 38-39 are under consideration by the examiner.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's arguments filed 4/3/01 have been fully considered but they are not persuasive.

**Applicant is advised to use the correct application number in their communication.**

**The correct application number is 08/669,656 not 09/669,656.**

#### ***Claim Rejections - 35 USC § 112***

Claims 8, 17, 30-33, and 38-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

This rejection is maintained for reasons of record as applied to claims 8, 17, and 30-33 and newly applied to claims 38-39 for the same reasons.

It is noted that the claims are being interpreted as being open (i.e. comprising) and not limited to just the coding portions. As such, the claims encompass the genomic sequences which are in fact contemplated by the disclosure. (See page 5, last line.) The gene structure or genomic sequences are not disclosed by the specification and thus the specification and claims fail to meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

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Applicant's argument with respect to comment 14 of the Guidelines is not persuasive. This comment appears to be with respect to degenerate sequences encoding a protein. It does not appear to address genomic sequences or gene structures that can be considered to encode amino acid sequences but still contain additional non-coding sequence that has not been described. It is noted that no new training materials have been disseminated. Note also that the response to this comment cautions that this does not mean applicant was in possession of any particular species from the broad genus (such as the genomic or gene sequence).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Herman et al. (U.S. Patent No. 6,184,349) discloses SEQ ID NOS: 1-2 and 10 which have high but not identical similarity to SEQ ID NOS: 1-2 and 4-8 of the instant application.

Claims 9-10, 13-14, and 18-33 are allowable in view of applicant's amendment removing their dependency upon claim 8.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen, whose telephone number is (703) 308-0666. The examiner can normally be reached on Monday-Friday from 9:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028. Official FAX communications may be directed to either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning the formalities of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703) 308-0009.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Marianne P. Allen*  
MARIANNE P. ALLEN  
PRIMARY EXAMINER  
~~GROUP 1800~~  
Au/631